

103. In rejecting the claims, U.S. Patents 5,963,916 to Kaplan; 5,959,411 to Doerr et al., 5,710,884 to Dedrick (References A-C, respectively, in the December 13, 1999 Office Action) and 5,774,666 to Portuesi (Reference A in the April 4, 2000 Office Action) were cited. Claims 83-92 have been added and thus, claims 2-92 remain in the case. The Examiner's rejections are traversed below.

Newly Cited Prior Art

U.S. Patent 5,774,666 to Portuesi

The Portuesi patent is directed to a system and method for displaying uniform resource locators (URLs) embedded in a time-based medium. As illustrated in Figs. 2 and 3 and described at column 4, line 47 to column 6, line 19, movie file 8 includes audio track 16, image track 18 and associated URL track 20. The URL track 20 contains URLs 26 that are defined to be displayed with associated images in the image track 18, as illustrated in Fig. 3. Only the URLs are automatically displayed; the data associated therewith is displayed only after a user selects one of the URLs.

U.S. Patent 5,959,411 to Doerr et al.

The Doerr et al. patent is directed to a multimedia preview and data collection kiosk system provided for the purpose of previewing content, such as movies before renting, purchasing, or viewing in a theater (see, e.g., column 2, lines 48-55).

Changes to the Specification and Substitute Specification

In the Amendment entered by the April 4, 2000 Office Action, the specification was amended to indicate the full continuing data for this application, i.e., that this application is a divisional of U.S. Patent Application Serial No. 08/838,082 filed April 15, 1997, now U.S. Patent No. 5,987,525, and U.S. Patent Application Serial No. 09/060,876 filed April 15, 1998 and to incorporate the contents of both parent applications by reference. The subject application filed on August 24, 1999 was a copy of Serial No. 08/838,082, but Serial No. 09/060,876 which is a continuation-in-part of Serial No. 08/838,082 was identified as the parent application when the subject application was filed. The changes to the specification

amends the application to include the contents of Serial No. 09/060,876 . A Substitute Specification, a marked-up specification indicating the changes and a copy of the specification in Serial No. 09/060,876 (Exhibit C) are attached hereto. Since the previous Amendment has already been entered to incorporate the contents of Serial No. 09/060,876 by reference, amendment of the specification to include the contents of Serial No. 09/060,876 is requested.

Rejection under 35 U.S. C. § 102(e)

In item 3 on pages 2-3 of the Office Action, claims 2-5, 22, 28, 31, 32, 35, 36, 38, 41 and 81 were rejected under 35 U.S.C. § 102(e) as anticipated by Doerr et al. As discussed above, Doerr et al. is directed to a system for previewing multimedia content, such as "movies, videos, music," (Abstract, line 1) etc. using remote kiosks at "strategic locations" (column 2, line 39), while the present invention is directed to monitoring what happens when a recording that has already been purchased is played. The independent claims have been amended to recite "collecting use data associated with a recording, fixed in a medium possessed by a user" (e.g., claim 2, lines 4-5). The objective of the system disclosed in Doerr et al. is "Multimedia Preview and Data Collection" (title, emphasis added). It is clear that the medium containing the content is not possessed by the use at the time that the previewing occurs. Since a similar limitation is recited in all of the independent claims, it is submitted that all of the claims patentably distinguish over Doerr et al.

Rejection under 35 U.S.C. § 103

In items 4-5 on pages 3-4 of the Office Action, claims 6-9, 10-21, 23-36, 29, 30, 33-37, 39, 40, 42 and 78-80 were rejected under 35 U.S.C. § 103 as unpatentable over Doerr et al. in view of Dedrick or Kaplan. It is submitted that the addition of either Dedrick or Kaplan does not overcome the deficiencies of Doerr et al. Since all of these claims depend from claims discussed above with respect to Doerr et al. taken alone, it is submitted that claims 6-9, 10-21, 23-36, 29, 30, 33-37, 39, 40, 42 and 78-80 patentably distinguish over Doerr et al. in view of Dedrick or Kaplan for the reasons discussed above.

In items 6-8 on pages 4-6 of the Office Action, claims 2, 22, 43-77 and 82 were rejected under 35 U.S.C. § 103 as unpatentable over Portuesi in view of Kaplan, Dedrick or Doerr et al. Portuesi has a filing date of October 18, 1996. A Declaration under 37 C.F.R. § 1.131 is submitted herewith establishing conception of the invention recited in the claims prior to April 16, 1996. Therefore, Portuesi is not prior art and withdrawal of the rejections based on Portuesi is respectfully requested.

New Claims

Claims 83-92 have been added to recite collecting use data for multiple recordings, as described at, e.g., page 6, lines 15-18 of the substitute specification. Since claims 83-92 depend from claims that are allowable for the reasons discussed above, it is submitted that claims 83-92 are in condition for allowance.

Summary

It is submitted that the prior art references cited by the Examiner do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 2-92 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

If any fees are required in connection with the filing of this Amendment, please charge same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

By: Richard A. Gollhofer
Richard A. Gollhofer
Registration No. 31,106

700 Eleventh Street, N.W.
Washington, D.C. 20001
(202) 434-1500

Date: 10/4/00

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CERTIFICATE UNDER 37 CFR 1.8(a)
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231
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STAAS & HALSEY
By: Regina St. Pierre
Date: 10/4/00

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